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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 03/04/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

AS18

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 12/18/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 9-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 9-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Upon reconsideration, the pending final rejection of the claims has been withdrawn for the following reasons. Initially it is noted that dependent claim 20 has not been examined, and also dependent claim 19 has, while noted as rejected on the cover sheet, also not been discussed at all in the prosecution. Finally, upon reconsideration, the Examiner is entering applicants' Rule 116 amendment filed December 18, 2002 in which claims 14 and 15 have been put in independent form. However, it is noted that both of these claims are now also rejected on prior art grounds, as set forth later in the Office action.

3. Claims 13, 16 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, claim 13 is considered vague, indefinite and confusing in that the phrase "suitable for hot pressing at temperatures below 120°C" in an article claim is not understood, i.e. what constitutes "suitable"? Additionally, it appears that this claim should have a lower limit with respect to the temperature limitation. As to claim 19, it is noted that this claim is dependent upon claim 13 and does nothing to clarify what

Art Unit 1771

constitutes "suitable". As to claim 16, it is not clear whether this is a method of making claim<sup>or</sup> a method of use claim and also what constitutes "is used for said bonding" in an article claim.<sup>?</sup> Restated differently, claims 13 and 16 are not understood in their present form.

4. Claims 9-14 and 16-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EPA -619, taken either individually, or in view of EPA -623, substantially for the reasons set forth in paragraph No. 3 of the final rejection, Paper No. 10 as substantially reiterated in paragraph No. 1 of the Advisory Action Paper No. 12, together with the following additional observations. Initially the Examiner notes that the presence of holes in the adhesive layer, i.e. the "punched film section"<sup>in claim 14</sup> is believed well within the ordinary skill of one in the electrical laminate art who may wish to punch holes in the adhesive layer for a variety of reasons related to various electrical related applications the resultant article may have. The Examiner further notes that applicants throughout the prosecution have failed to address the issue, or even mention the issue, that "a selection of particle size is well within the ordinary skill of the art, depending upon what sort of electrical conductivity values are required." Finally, as to the relied upon prior art combination, the Examiner further believes that a person skilled in the art would know that he could use silver

Art Unit 1771

coated particles having diameters which exceed the adhesive layer thickness in order to improve the electrical conductivity. The fact that the particles may be deformed (an alleged flaw which applicants have strenuously argued) is not believed to be pertinent since the particles are not required to be spherical in nature, and there are <sup>also</sup> no restrictions on what the diameter of the particles versus the diameter of the glass core is.

5. Claims 9-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -743 Patent Abstract or its complete German original taken in view of EPA -623, substantially for the reasons set forth in paragraph No. 6 of Paper No. 6, together with the following additional observations. Upon reconsideration, this grounds of rejection has been reinserted since the Examiner believes that the combination clearly renders obvious the claimed genus of adhesive films and accompanying methods. In particular, the method of implanting electrical modules in a card body as set forth in claim 15 is believed clearly disclosed by the relied upon prior art combination. Applicants have argued earlier in their response of July 26, 2002, Paper No. 9 that the secondary -623 reference "teaches that the spherical particles used therein should be readily deformable to the thickness of the adhesive between the particles. Glass beads are not deformable, however." However, this particular grounds of rejection is, upon reconsideration, again traversed



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No.	Doccode	Number of pages
1	A...	1
2	CLM	4
3	REM	4
4	XT/	1

Total number of pages: 10

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